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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,322	04/26/2001	Casey William Norman	1391-CON-00	1969

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IP DEPARTMENT OF PIPER RUDNICK LLP  
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EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/844,322

Applicant(s)

NORMAN ET AL.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-23,25,26 and 28-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23,25,26 and 28-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The amendment filed 12/24/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

A] Injection molding provides a seamless garment.

B] the garment has a molded shape to fit over the varied surfaces of the doll.

C] the doll is preferably articulated the shoulder/neck.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching of the average modulus of elasticity is less than  $1 \text{ MN/M}^2$  as recited in claims 22, 30 and 47, the doll is articulated at a joint selected from the group consisting of neck, and hips as recited in claims 34 and 38, the 100% modulus of elasticity is between 240 and 280  $\text{KN/M}^2$  as recited in claims 31, 42 and 51. Also, proper antecedent basis should be provided in the specification for the teaching of the 300% modulus of elasticity is between 440 and 490  $\text{KN/M}^2$  as recited in claims 32 and 43 and 100% modulus of elasticity is between 120 and 350  $\text{KN/M}^2$  as recited in claim 50. No new matter should be entered into the application.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 31-32, 41-43 and 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear what the applicant refers as 100% or 300% modulus of elasticity.

5. Claims 21-22, 27, 30-32, 41-43, 47 and 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the teaching of “a seamless injection molded thermoplastic elastomer doll's garment having a molded shape to fit over the varied surfaces of the doll” as now recited in claims 21-22, 38 and 47. The specification also does not provide support the limitation “the average modulus of elasticity is less than 1 MN/M<sup>2</sup>” as recited in claims 22, 30 and 47, “the injection molded thermoplastic elastomer is colorless” as recited in claim 27, “the 100% modulus of elasticity is between 240 and 280 KN/M<sup>2</sup>” as recited in claims 31, 42 and 51.

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Additionally, the specification does not provide support the limitation "the doll is articulated at a joint selected from the group consisting of neck, and hips" as recited in claims 34 and 38.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-23, 25-26, 28, 30-33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian et al, hereinafter O'Brian.

Kramer discloses most of the elements of these claims including a doll, a doll's garment [col 1 lines 51-57] formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch [less than 1 MN/M<sup>2</sup>].

Kramer does not disclose a seamless injection molded thermoplastic elastomer doll's garment as recited in claims 21-22, a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 26 and the garment is less than 8 cm in height as recited in claim 28.

O'Brian in at least some of the embodiment such as Figs 2 and 3 teaches the concept of providing seamless [col 2 lines 38-53] injection molded thermoplastic elastomer [col 3 lines 54-56] doll's garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of the

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seamless injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

With respect to claim 26: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the Kramer's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

With respect to claim 28, it would have been obvious to further provide the garment of Kramer in the claimed height for the purpose of making the devices easier to play with and to accommodate for small dolls.

8. Claims 20 and 29 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian as applied to claims 21-23, 25-28, 30-33 and further in view of Yasuda.

Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene [col 3 lines 18-54] in order to make clothes for dolls [as the constituent element of dolls]. It would have been obvious to make the modified device of Kramer out of thermoplastic elastomer containing styrene as taught by Yasuda in order to give the device more flexibility.

9. Claim 34 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian and further in view of Gross.

Modified device of Kramer discloses most of the elements of these claims, but does not disclose a play set comprising a doll wherein the doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips.

Gross is cited to show a desirability to have a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees. It would have been obvious to further provide the modified device of Kramer with the articulated doll as disclosed by Gross, for the purpose of making the device more enjoyable for the children to play with.

10. Claims 35-37 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian, Gross and further in view of Yasuda.

Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene [col 3 lines 18-54] in order to make clothes for dolls [as the constituent element of dolls]. It would have been obvious to make the modified device of Kramer out of thermoplastic elastomer containing styrene as taught by Yasuda in order to give the device more flexibility.

11. Claims 38-51 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian, Yasuda and Gross.

Kramer discloses most of the elements of these claims including a doll, a doll's garment [col 1 lines 51-57] formed from a flexible sheet of polymer plastic material

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between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch [less than 1 MN/M<sup>2</sup>].

Kramer does not disclose a seamless, colorless injection molded thermoplastic elastomer doll's garment, the specific thermoplastic elastomer material, a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees as recited in claims 38 and 47. Additionally, Kramer does not disclose a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 46.

O'Brian in at least some of the embodiment such as Figs 2 and 3 teaches the concept of providing seamless [col 2 lines 38-53] injection molded thermoplastic elastomer [col 3 lines 54-56] doll's garment. It would have been obvious to use the teaching of the seamless injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

Yasuda discloses using the thermoplastic elastomer containing styrene [col 3 lines 18-54] in order to make clothes for dolls [as the constituent element of dolls]. It would have been obvious to further make the device of Kramer out of thermoplastic elastomer containing styrene as taught by Yasuda in order to give the device more flexibility.

With respect to claim 46: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the Kramer's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.



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Gross is cited to show a desirability to have a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees. It would have been obvious to further provide the device of Kramer with the articulated doll as disclosed by Gross, for the purpose of making the device more enjoyable for the children to play with.

### ***Response to Arguments***

12. Applicant's arguments filed 12/24/03 have been fully considered but they are not persuasive.

In response to applicant's argument on pages 8 regarding that those of ordinary skill in the art readily know that injection molded items do not have seams and that injection molding provides seamless garments. Examiner disagrees; just because the items are made by injection molding does not automatically make them seamless. However, since the applicant appears to imply that seamless is an inherent property of injection molding, applicant does not need to enter the word "seamless" into the claims. Additionally, since the word "seamless" was not in the original disclosure as filed and it is not going to be allowed in.

In response to applicant's argument in page 8 last paragraph that the antecedent basis for the different average modulus of elasticity are found at varying location, the examiner would like to point out that all the references in the specification in regard to different modulus of elasticity are directed to the  $\text{MN/M}^{-2}$  [negative 2] and to not  $\text{MN/M}^2$ .

In response to applicant's argument in page 9 first paragraph, the examiner would like to point out that that the Glossary of Urethane Terminology can not be found in the papers filed and because of the reasons already noted the rejection stands.

In response to applicant's argument in page 9 third paragraph regarding the rejection of Claims 21-23, 25-28 and 30-33 over the hypothetical combination of O'Brian with Kramer, the examiner would like to point out that Kramer reference was only applied to show a doll's garment formed from a flexible sheet of polymer plastic material between 2 mm and 6 mm in thickness and with modulus of elasticity of less than 1 MN/M<sup>2</sup>. The fact that the polymer plastic material of Kramer is not selected for the same reasons that the thermoplastic elastomer material of the invention is selected and that the thicknesses of Kramer are not selected for even remotely the same purposes as the thicknesses of this invention are irrelevant.

In response to applicant's argument in page 9 last paragraph that one of ordinary skill in the art would have utterly no incentive or motivation to combine O'Brian with Kramer. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time

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the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

In this case, the artisan would have been motivated to use the teaching of the seamless injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility. Also, to further modify the Kramer's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice. Additionally, it would have been obvious to further provide the garment of Kramer in the claimed height for the purpose of making the devices easier to play with and to accommodate for small dolls.

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Thus, taking into account all of the knowledge in the art as previously discussed, the real reason for the applicant's claims of non obviousness may simply be that Kramer does not identically disclose all of the elements of the claims as amended after the first Office Action. Such reasoning is clearly improper.

In response to applicant's argument in page 11 third paragraph that of O'Brian is not applicable because it does not anywhere mention the words "injection" or "elastomer". O'Brian at the least teaches a single piece of resilient thermoplastic material such as polyethylene, polystyrene or the like but does not specifically teach an elastomer. However, the material that expressly taught in O'Brian reference would encompass various types of elastomer, which are well known resilient material. Surely the applicant is not suggesting that he is the first to recognize that elastomer is a resilient material. Additionally, injection molding is a well-known process and since the reference teaches molding it may include any known type of molding including injection molding.

In response to applicant's argument in page 12, that applicants injection molded thermoplastic elastomer garments are seamless, which is inherently not the case in Yasuda by virtue of the fact that the Yasuda figures which illustrate the inherently resulting seams associated with laminating multiple layers together. The examiner would like to point out the nothing in the specification taught that the word "seamless" encompassed no laminated as already noted and shown by applicants remark. Furthermore, since the word "seamless" was not in the original disclosure as filed and it is not going to be allowed in **[New Matter]**.

In response to characterization or style, applicant may styled the rejections as hypothetical. However, the examiner has made a prima facie case which applicants have not overcome therefore the claims are not allowed.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700